

IN-5530/BC140047

REMARKS

1. Rejection of claim 14.

The PTO has maintained the rejection of dependent claim 14. In particular, the PTO states in item no. 3 of the office action of November 18, 2004 that,

Applicant's argument against the rejection of claim 14 (set forth in item 3 of office action November 05, 2000) is far from convincing. It is still not clear what is precisely encompassed by the scope of this claim. (Examiner finds that this claim encompass "a coating" or "a coating material" and fails to further limit the scope of claim 1 from which it depends).

(Office Action of 11/18/04, page 2)

Applicant appreciates the detailed response but respectfully submits that the instant amendment of claim 14 renders this rejection moot. Support for this amendment may be found on page 84, lines 20-28, page 85, lines 1-24, and page 89, lines 12-13.

Reconsideration and removal of the rejection with respect to dependent claim 14 is respectfully requested.

The Undersigned notes that, in the interests of consistency, claim 33 has been similarly amended and claim 33 canceled.

2. Rejection of claims 1-11, 14, 15, 17-28, 33, 34, and 39 under 35 U.S.C. §103(a) as being unpatentable over Reusmann et al., U.S. 6,403,701, hereafter "Reusmann" or "701" in view of Kawakami et al., EP 081994, hereafter "Kawakami" or "994".

The PTO has maintained the rejection of independent claims 1, 2, and 3, as well as those claims depending there from.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

IN-5530/BC1-0047

This standard is not met with the instant combination of references.

Reusmann is relied upon for its description of a mixer system, which includes (A) many water-free base colors and (B) a pigment-free aqueous component (abstract). Component (A) contains less than 55 by wt of water, one coloring and/or special effect pigment, an organic solvent, a water thinnable or water-dispersible first binder and desired auxiliaries and additives. Component (B) comprises aqueous dispersion of polyurethane resin (column 2, line 60 to column 3, line 3). Components A and B are said to read respectively on A1 and B of Applicant's instant claims 1, 2, line 3. Rheology controlling additive is also added in the component B (column 10, line 63 to column 11, line 17). Polyurethane is one of the suitable binders (column 3, line 64 to column 4, line 20). The coating compositions can be applied by spraying on various substrates in multi-coats (column 13, line 43, line 43 to column 14 line 23).

The PTO recognizes that the '701 patent does not disclose or suggest a composition comprising the combination of Applicant's components (A1) and (B) with a component (A2) that requires binder, pigment and water.

The PTO relies upon Kawakami to rectify this deficiency of the '701 patent. Per its Abstract, the '994 application describes paper coating compositions that require a particular thermosetting resin, conventional pigment, binder and water.

It is the PTO's position that it would have been obvious to include the paper coating composition of the '994 application in the system of the '701 patent. Motivation for such a combination is said to be disclosed in the last paragraph of the Abstract of the '994 application, i.e., '...to make a coated paper which has good water resistance (due to the resin (Y)) whilst being receptive to rotary offset printing ink.'

Applicant greatly appreciates the detailed basis of rejection but must respectfully disagree.

Applicant's inventions of independent claims 1, 2, and 3 require the combination of an organic solvent based base color (A1), an aqueous base color (A2), and an aqueous pigment-free mixing varnish (B). Although the solvent based base color (A1) may be either color and/or effect imparting, it is an aspect of Applicant's claimed inventions that the aqueous base color (A2) be color-imparting.

IN-5530/BC1-0047

The cited combination of the compositions of the '701 patent and the '994 application fail to disclose Applicant's claimed combination. In particular, the cited combination fails to disclose all of the required elements of Applicant's claims 1, 2, and 3. In addition, Applicant must respectfully disagree with the PTO's most recent comments and submits that the cited combination fails to provide any suggestion to do what Applicant has done.

For example, the '994 application is concerned solely with paper coating compositions that provide increased water resistance to the coated paper. A review of the teachings of the '994 application indicate that the disclosed coatings are not intended to be color imparting. Most of the pigments disclosed in on page 8, lines 22-27 of the '994 application are filler pigments as taught by Applicant on page 54, lines 5-29, and page 55, lines 1-14 of Applicant's Specification. As indicated on page 73, lines 24-27, Applicant's component (A2) must comprise at least one color pigment. Filler pigments do not satisfy the definition of color pigments.

Thus, the compositions taught by the '994 application on page 22, lines 13-26 fail to disclose or suggest Applicant's aqueous color-imparting base color (A2). To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974); MPEP 1243.03. The combination of Examples 3-16 with the components of the '701 patent fail to provide the combinations required by Applicant's claims 1, 2, and 3. In particular, there is no color-imparting aqueous base color in such combinations as is required by Applicant's claimed inventions.

In addition, there is no motivation in the '994 application to combine its complete and 'stand alone' paper coatings with the compositions of the '701 patent. Rather, the teachings of the '994 application indicate that the disclosed coatings are complete and did not require admixture with any other components. The disclosed weight %'s and solids concentrations of the '994 application do not provide for admixture with any other coating components. Finally, the working examples of the '994 application indicate that desirable water resistance is obtained solely with the use of the disclosed paper coating compositions.

IN-5530/BC1-0047

The PTO has suggested that motivation to do what Applicant has done is provided by the '994 application's teachings with regard to increased water resistance. However, it is respectfully submitted that the '994 application's teachings with respect to improved water resistance are confined to the advantages resulting from the use of the particularly disclosed thermosetting resin. This thermosetting resin results from the reaction of (a), (b), and a resin (Y) obtained by reacting (i), (ii), and (iii).

Nothing in the '994 application provides a reason to combine a solvent borne base color (A1) with a pigment free mixing varnish (B) and an aqueous color-imparting base color (A2). The PTO is encouraged to provide a citation to any such suggestion.

Instead, it is submitted that the motivation suggested by the PTO is apparent only with the benefit of the hindsight teachings of Applicant's Specification. A statement that modifications of the prior art to meet the claimed inventions would have "*well within the ordinary skill of the art at the time the claimed invention was made*" because the references teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); MPEP 2143.01.

Nothing in the '994 application suggests that the disclosed paper coating compositions should be combined with a solvent based composition (A2) and an aqueous pigment free varnish (B). Rather, the teachings of the '994 application indicate that the disclosed compositions are intended to be wholly complete coatings in and of themselves and nothing except Applicant's teachings suggest that they should be combined with components such as Applicant's (A1) and (B). The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Fritch*, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

Accordingly, the cited combination fails to provide a *prima facie* case of obviousness as to the inventions of independent claims 1, 2, and 3. In particular, the cited combination fails to provide all of the required limitations as well as any motivation to do what Applicant has done.

IN-5530/BC1-0047

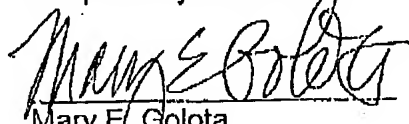
Reconsideration and removal of the rejection is thus respectfully requested with respect to Applicant's independent claims 1, 2, and 3. Similarly, reconsideration and removal of the rejection is also requested as to dependent claims 4-11, 14, 15, 17-28, 33, 34, 36, and 39, in as much as these dependent claims incorporate the limitations of independent claims 1, 2, or 3.

IN-5530/BC1-0047

CONCLUSION

Applicant respectfully submits that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,



Mary E. Golota
Cantor Colburn LLP
Registration No. 36,814
(248) 524-2300

February 18, 2005

CORRESPONDENCE ADDRESS ONLY

BASF Corporation
26701 Telegraph Road
Southfield, Michigan 48034-2442
Customer No. 26922